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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,675	03/24/2006	Thomas Hanna	2003P11505WOUS	3540

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SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER
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ELLIOTT IV, BENJAMIN H

ART UNIT	PAPER NUMBER
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4144

MAIL DATE	DELIVERY MODE
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12/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,675	<b>Applicant(s)</b> HANNA ET AL.	
	<b>Examiner</b> BENJAMIN ELLIOTT	<b>Art Unit</b> 4144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Acknowledgment is made of amendment filed on 11/10/2008. Claims 4-7 have been amended.

#### ***Drawings***

2. The amended drawings filed on 11/10/2008 have been entered.

#### ***Specification***

3. The amended abstract and specification filed on 11/10/2008 have been entered.

#### ***Response to Arguments***

4. Applicant's amendments filed on 11/10/2008 with respect to claims 4-7 necessitated the new grounds of rejection presented in this Office action. Applicant's arguments with respect to claims 4-7 have been fully considered but are moot in view of the new grounds of rejection.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 4-8 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 2005/0060411 A1 by Coulombe et al (hereinafter "Coulombe").

As per Claim 4, Coulombe discloses **a method for operating a Session Initiation Protocol (SIP) network entity in a communication channel between a first SIP user agent and a second SIP user agent in a packet based communication network** ([0004]. SIP provides for communication between devices that have multimedia capabilities.) **with available a first set of communication features at the first end point supported by the first SIP user agent and available a second set of communication features at the second end point supported by the second SIP user, including at least one communication feature in the second set of communication features which is not supported by the first SIP user agent** ([0011]. The user agents (Abstract) send descriptors to a proxy server describing their media characteristics. A determination is made as to their incompatibility. An adaptation server alters the either first or second descriptions to meet the capabilities of either the first or second terminals.), **comprising:**

**acting as a client application for the first SIP user agent and as a server application for the second SIP user agent** ([0035]. Each user agent comprises a user agent client that initiates requests and a user agent server that generates the responses

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to the requests.); **and**

**arranging to exchange signaling information with the first and second user agents to enable the second SIP user agent to utilize the at least one communication feature which is unsupported by the first SIP user agent during communications with the first SIP user agent** ([0051]. The adaptation server determines the resources required to modify the media stream between the two user agents. [0053]. Once the appropriate acknowledgement messages have been sent, communication is then established.).

As per Claim 5, Coulombe discloses **the method as claimed in claim 4, wherein a call routing addresses signaling information that is exchanged between the SIP network entity and the first and second SIP user agents or the SIP network entity and the communication network** ([0046]. IP addresses and port numbers are included in the descriptors and are modified if necessary for redirection from the terminals to the adaptation server for transcoding.).

As per Claim 6, Coulombe discloses **the method as claimed in claim 5, wherein a payload routing addresses payload data received at the SIP network entity for routing to the first or second end points SIP user agents** ([0046]. The adaptation server must be utilized to allow modification of, for example video data between two terminals if said terminals are incompatible in that respect.).

As per Claim 7, Coulombe discloses **a network entity for operating a Session Initiation Protocol (SIP) network in a communication channel between two end**

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**points in a packet based communication network** ([0035]. User agents may be mobile terminals.), **comprising:**

**a first SIP user agent being a first end point and supporting a basic SIP communication feature set; a second SIP user agent being a second end point and supporting an enhanced SIP communication feature set** ([0029]. An example given is the concept of caller identification in which instead of simply displaying the caller's identification, a supported feature may allow for displaying business card information as well.); **and**

**a SIP Basic Call Enhancer located within the communication channel between the first and second SIP user agents that enables the second SIP user agent to utilize the enhanced SIP communication feature set which is unavailable to the first SIP user agent when communicating with the first SIP user agent** ([0011]. The user agents (Abstract) send descriptors to a proxy server describing their media characteristics. A determination is made as to their incompatibility. An adaptation server alters the either first or second descriptions to meet the capabilities of either the first or second terminals.).

As per Claim 8, Coulombe discloses **the network entity as claimed in claim 7, wherein the basic SIP communication feature set supports session initiation and termination** ([0039]. The method includes the ability to send invite messages and receive descriptions of session terminators.).

As per Claim 10, Coulombe discloses **the network entity as claimed in claim 7, wherein the SIP Basic Call Enhancer comprises:**

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**a user agent server part that exchanges messages with the first SIP user agent, a user agent client part that exchanges messages with the second SIP user agent** ([0035]. Each user agent comprises a user agent client that initiates requests and a user agent server that generates the responses to the requests.), **a local configuration store that stores information required for the Basic Call Enhancer to route messages** ([0076]. Storage devices or storage in a database are accessible for facilitating adaptation functions of the invention.), **a call router that involves the first and second SIP user agents in an enhanced SIP session, a session controller that transfers messages from the user agent server part to the call router and from the call router to the user agent client part to keep track of session states and progress** ([0051]. The adaptation server determines the resources required to modify the media stream between the two user agents. [0053]. Once the appropriate acknowledgement messages have been sent, communication is then established.), **and a payload router that manages media streams so that the Basic Call Enhancer functions as a virtual end point to both the first and second SIP user agents in respect of the media streams** (Abstract. Either the originating or terminating servers make the determination as to which will conduct the adaptation on the media streams.).

As per Claim 11, Coulombe discloses **the network entity as claimed in claim 7, wherein the SIP Basic Call Enhancer functions as a client application for the first end point** ([0036]. The SIP server of the application may be used to update a user's profile in a profile server.).

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As per Claim 12, Coulombe discloses **the network entity as claimed in claim 7, wherein the SIP Basic Call Enhancer functions as a server application for the second endpoint** ([0035]. The server of the invention receives requests from user agents.).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation



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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2005/0060411 A1 by Coulombe et al (hereinafter "Coulombe"), and further in view of US patent 6,498,791 B2 by Pickett et al (hereinafter "Pickett").

As per Claim 9, Coulombe discloses **the network entity as claimed in claim 7, wherein the enhanced SIP communication feature set supports session initiation and termination** ([0039]. The method includes the ability to send invite messages and receive descriptions of session terminators.), but is silent on **an enhanced set of telephony features selected from the group consisting of: call waiting, call transfer, conference calling, call hold, and music on hold.**

However, Pickett teaches the digital phones of the disclosed invention have features which include: music on hold (col. 41, lines 40-48), call hold (col. 56, lines 39-40), call conferencing (col. 56, lines 66-67), call transfer (col. 57, lines 9-12), and call waiting (col. 57, lines 19-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Coulombe to include call waiting, call transfer, conference calling, call hold, and music on hold taught by Pickett, because in an environment where a variety of voice and data communications are valued (col. 1,

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lines 59-60), there exists a need to provide these features and services in a manner that yields efficiency (col. 2, lines 43-46).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN ELLIOTT whose telephone number is (571)270-7163. The examiner can normally be reached on Monday thru Thursday, 7:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on 1-571-272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. E./  
Examiner, Art Unit 4144

/Taghi T. Arani/

Supervisory Patent Examiner, Art Unit 4144